

REMARKS

Claims 1-64 are in the application for consideration.

Applicant respectfully traverses the restriction requirement entered by the Examiner in this application. Applicant submits that the restriction requirement is inappropriate, and inconsistent with the policies and objectives of the PTO, and is inconsistent with an effective and efficient patent system. Applicant does not believe that this result was intended by the Examiner, but that such is an unintended product of the Office Action to which this response is filed. For the reasons set forth below, Applicant requests that the restriction requirement be withdrawn.

The present application currently contains 64 claims, and only three of which are independent claims. The Examiner has lodged a two way restriction, and identified four general species categories with respect to one of the two restricted subject matters. Each of these four species has been further divided into multiple sub-species. For example to illustrate the problem, Applicant is apparently required to elect a single "species" for prosecution from what are at least hundreds of separate possible "species" combinations as presented by the Examiner,

By definition, because the Examiner is requiring election of a single species, each identified species --at each level-- must be considered to be patentably distinct or such restriction would be improper under the 37 C.F.R. §1.146 and the guidelines of the M.P.E.P. As stated in the M.P.E.P., "[t]he term 'distinct' means that two or more subjects as disclosed are related, for example, as combination and part (sub combination) thereof, process and

apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)," M.P.E.P. §802.01.

Thus, the Examiner's restriction can be used by Applicant to overcome future art rejections. To illustrate the consequences of the restriction requirement, for example and by way of example only, a prior art reference which only expressly or impliedly refers to a process involving one of the subspecies and no other subspecies cannot be used to reject any claim of Applicant to another subspecies. The PTO would be prohibited from making a 35 U.S.C. §103 rejection of such in such instance (in the absence of other art). Dividing a patent application into an excessive number of "species" not only creates undue financial and time burdens on Applicant but accordingly also results in estoppel for the PTO. This seems inconsistent with the policies and objectives of the PTO, and is inconsistent with an effective and efficient patent system.

A result of the Examiner's restriction requirement is resulting in hundreds of combinations, obviously, an excessive number of patentably distinct species. Under 35 U.S.C. §121, Applicant is required to select one of the different species for prosecution. If these claims are allowed, Applicant is entitled under 37 CFR §1.141 to consideration of additional species if written in dependent form or to include the limitations of a generic claim. Alternatively, Applicant has the option to file any number of separate patent applications for each of the patentably distinct species and to not

have such applications subject to a rejection for double patenting over any of the other applications.

Additionally, because the Federal Circuit has informed the patent community that unclaimed subject matter is dedicated to the public, Applicant is forced to insure that all distinct embodiments are claimed, see Johnson & Johnston Associates Inc. v. R.E. Service Co., 285 F.3d 1046 (Fed. Cir. 2002), Maxwell v. J. Baker, Inc., 86 F.3d 1098 (Fed. Cir. 1996). Although Applicant believes that all embodiments have been claimed, the Examiner's identification of so many species, if uncorrected, could create doubt that the original claims fully claimed the disclosed species in all the combinations.

Further and/or alternately considered, the excessive number of species restrictions which has been made seems counter to the provisions of 35 U.S.C. §112. Such provides that an Applicant is to present claims as to what it "regards" as its invention. Accordingly, the PTO should review the invention as Applicant "regards" it, which is how an Applicant claims it. Yet, the Examiner's species restrictions may include, or apparently includes, some specific sub-species which are not specifically spelled out in any claim, for example depending upon how the Examiner's use of "specific" in subspecies B and C is interpreted (although such are generically covered). Accordingly at least in some instances, and in light of the voluminous alleged species, it appears the Examiner is not analyzing Applicants invention in the manner which Applicant regards it but rather in the manner the Examiner either regards it or desires it to be claimed.

The application as presented to the Examiner includes 9 pages of detailed description and 64 claims. Applicant submits that a restriction requirement that resulted in every claim being a separate species would likely never be appropriate. Applicant respectfully submits that a restriction requirement that results in more species than there are claims submitted, and in particular a requirement as here, which requires election between an apparent hundreds of distinct species is not appropriate, and if intentional, would be a clear abuse of discretion. However, once again, Applicant wishes to repeat that Applicant does not believe that the Examiner intended the above-described result. However, because of the impacts as described above, Applicant submits that it is important that the present restriction requirement leading to the above-described results be withdrawn.

It is respectfully requested that the Examiner examine all claims in this application at this time. Group I to claims 1-62 is hereby provisionally elected. Further, the species of A-1, B-inorganic, C-inorganic, and D-1 is hereby provisionally elected. Claims 1-8, 11-15, 18-20, 24-26, 30-32, 34-40, 43-47, 50-52, 56-58 and 62 are generic to or readable on the above election.

This application is believed to be in immediate condition for allowance,
and action to that end is requested.

Respectfully submitted,

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